



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

COPY MAILED

MAR 26 2007

In re Application of
ROMASCHIN et al
Application No.: 10/614,678
Filing Date: July 7, 2003
Attorney Docket No.: 1148-1-002 CIPP

OFFICE OF PETITIONS

DECISION ON PETITION
UNDER 37 CFR 1.55

This is a decision on the petition under 37 CFR 1.55(c), filed November 2, 2006, for acceptance of an unintentionally delayed claim under 35 U.S.C. 119(a)-(d) for benefit of the filing date of foreign Application No. CA 2,097,952, filed June 8, 1993.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

- (1) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date and be included either in an oath or declaration (37 CFR 1.63(c)(2)) or in an Application Data Sheet (37 CFR 1.76(b)(6));
- (2) the surcharge as set forth in 37 CFR 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional.
(The Director may require additional information where there is a question whether the delay was unintentional.)

The instant petition fails to comply with item (1) above. In this regard, a review of the file record fails to disclose that the priority information was included in an oath or declaration or in an Application Data Sheet in accordance with 37 CFR 1.76(b)(6). Unless provided in an application data sheet, 37 CFR 1.63(c)(2) requires that the oath or declaration must identify the foreign application for patent or inventor's certificate for which priority is claimed under 37 CFR 1.55, and any foreign applications having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. Note MPEP 201.14, page 200-84 (Rev. 5, August 2006), last paragraph, second column.

In view of the above, compliance with 37 CFR 1.63(c)(2) or 37 CFR 1.76(b)(6) must be satisfied if applicant desires to claim priority to the foreign application noted in the petition. Any future petition should include a cover letter and be entitled "Renewed Petition under 37 CFR 1.55(c)."

Applicant is further advised that the amendments to the specification filed on July 9, 2004 and August 18, 2006 are improper. Specifically, the specification has been amended to state that U.S. Application No. 08/257,627 "is a national stage entry pursuant to 35 USC 111 of PCT/CA94/00325". However, a review of Office records indicates that U.S. Application No. 08/257,627 is not a national stage entry of international application number PCT/CA94/00325. Thus, any reference to U.S. Application No. 08/257,627 as a national stage entry of international application number PCT/CA94/00325 would be inappropriate. Additionally, applicant is directed to the new matter concerns set forth in the Office action mailed February 21, 2006.

With regard to item (3) above, the petition states that "the entire delay between the date the priority claim was due under (a)(1) and the date claim was filed (first on July 7, 2004 in an Amendment and Response and second on this date) was unintentional." This statement is interpreted as a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Bryan Lin at (571) 272-3303.

Bryan Lin

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

BM

Boris Milef
Legal Examiner
Office of Petitions